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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/310,073	05/10/1999	GARY R. ACKARET	10980623-1	8322

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FORT COLLINS, CO 80527-2400

EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/310,073

Applicant(s)

ACKARET, GARY R.

Examiner

CESAR B PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the application, and IDS filed on 5/10/99.

**This action is made Non-final.**

2. Claims 1-20 are pending in the case. Claims 1, 11, and 18 are independent claims.

The Examiner understands that this invention is directed towards the printing of forms on a PDA using Jetsend technology.

### *Drawings*

3. The drawings filed on 5/10/99 have been approved by the draftsman.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8, and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 8, and 19 recite: **“the cookie containing specific information detailing a user form to be printed”** (L.3-5), and **“storing...the form temporarily within a cookie of the client machine”** (L.2-4), respectively. The Examiner could not find support for these limitations

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in the specification; Applicant discloses a "cookie set" for storing the address of a device to send the selected form to (p.10,L.8-13, and p.12,L.13-15).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-2, 4-5, 11-14, and 17-18 rejected under 35 U.S.C. 102(e) as being anticipated by Laursen et al, hereinafter Laursen (Pat.# 6,065,120, 5/16/00, filed 12/2/97).

Regarding independent claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52). The forms are transmitted using an Internet protocol, such as HTTP.

Claims 2, and 5 are directed towards a computer system for implementing the apparatus found in claim 1, and are therefore similarly rejected.

Regarding claim 4, which depends on claim 1, Laursen discloses a browser capable of the accessing, displaying (rendering) of HTML forms, containing JAVA components (col. 14, lines 40-67).

Claims 11-14, and 17 are directed towards a computer program product on a computer-readable medium for storing the apparatus found in claims 1-2, 1, 1, and 1 respectively, and therefore are similarly rejected.

Claim 18 is directed towards a method for implementing the apparatus found in claim 1, and is similarly rejected.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Covert et al, hereinafter Covert (Pat. # 6,334,117 B1, 12/25/01, filed on 11/17/98).

Regarding claim 7, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HTML microbrowser (col. 15, lines 1-52). Laursen fails to explicitly disclose *a Java vending machine operative to pull a user selected Jetsend job*. Covert teaches the obtaining, and controlling of a print job by a Java applet (col.14,lines 12-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and

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Covert, because Covert teaches above a form displaying method for conveniently displaying one question or statement at a time on a PDA.

10. Claim 8, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Covert, as applied to claim 7 above, and further in view of Laor (Pat. # 6,041,309, 3/21/00, filed on 12/23/98).

Regarding claim 8, which depends on claim 7, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52). Laursen fails to explicitly disclose *store a cookie on the web browser of the client machine ....detailing a user selected form to be printed and a network address for the output device selected to generate the form*. Laor teaches the storage of a cookie in a client's computer for customizing user's document requests (col.1,lines 27-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, Covert and Laor, because Laor teaches above the customization of user's requests to align with user's preferences, i.e. device printing the documents.

Claim 19 is directed towards a method for implementing the apparatus found in claim 8, and therefore is similarly rejected.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Wright Jr. hereinafter Wright (Pat. # 5,704,029, 12/30/97).

Regarding claim 3, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML

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microbrowser (col. 15, lines 1-52). Laursen fails to explicitly disclose *a PDA*. Wright teaches the transferring, displaying (rendering) of a form to a PDA from a computer; the creation of the form takes place at the computer (col.7,lines 1-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Wright, because Wright teaches above a form displaying method for conveniently displaying one question or statement at a time on a PDA.

12. Claims 6, 9-10, 15-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of HP Jetsend Technology Making Device-To-Device Communication Simple, hereinafter Jetsend,

<http://web.archive.org/web/19980124223300/www.jetsend.com/Backgrnder.html> (p.1-6, 1/24/98).

Regarding claim 6, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52). Laursen fails to explicitly disclose *a jetsend capable hard copy output device*. Jetsend teaches the printing of a document using jetsend protocol, and assigning an address to a receiving device (p.1,lines 12-29, and p.2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Jetsend, because Jetsend teaches above the intelligent negotiation of information without user intervention.

Claims 9-10 are directed towards a computer system for implementing the apparatus found in claim 6, and are therefore similarly rejected.

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Claims 15-16 are directed towards a computer program product on a computer-readable medium for storing the apparatus found in claim 6, and therefore are similarly rejected.

Claim 20 is directed towards a method for implementing the apparatus found in claim 6, and is similarly rejected.

### *Conclusion*

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Laursen et al. (Pat. # 6,292,657), King (Pat. # 6,317,831), Crozier (Pat.# 5,701,423), The Jetsend Protocol, <http://web.archive.org/web/19980124230258/www.jetsend.com/Whitepaper.html>, 7/2/97, and Liao (Pat. # 6,292,833).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231



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Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry)


Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label  
“PROPOSED” or “DRAFT” ).

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).**

*CBP*

3/11/02

  
**STEPHEN S. HONG**  
**PRIMARY EXAMINER**